Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> JOHN K. ECKL

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Appeal No. 2003-2167
Application No. 09/903,500

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ON BRIEF

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Before FRANKFORT, FLEMING, and NASE, <u>Administrative Patent Judges</u>.

NASE, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 and

14 to 36, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to envelope inserting equipment, and more

particularly to such equipment which is utilized by production mailers to send bills or

statements to their customers (specification, p. 1). A copy of the claims under appeal is

set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the

appealed claims are:

Hogan   5,699,528   Dec. 16, 1997
Comesanas   5,802,498   Sept. 1, 1998

Claims 12, 14, 15, 17 to 23, 25 to 27, 29 to 34 and 36 stand rejected under

35 U.S.C. § 103 as being unpatentable over Comesanas.

Claims 16, 24, 28 and 35 stand rejected under 35 U.S.C. § 103 as being

unpatentable over Comesanas in view of Hogan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and

the appellant regarding the above-noted rejections, we make reference to the answer

(Paper No. 12, mailed March 19, 2003) for the examiner's complete reasoning in

support of the rejections, and to the brief (Paper No. 11, filed January 30, 2003) and

reply brief (Paper No. 14, filed May 22, 2003) for the appellant's arguments

thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to

the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence

of our review, we make the determinations which follow.

In the Grouping of Claims section of the brief (p. 4), the appellant stated that

Claims 12 and 14 to 36 stand and fall together. We have selected claim 18 as the

representative claim from that grouping of claims.

Claim 18 reads as follows:

A method for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising the steps of:
generate billing information for at least one recipient from a biller's computer;
prescribing delivery preferences for said billing information;
associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;

generating a printed billing statement from said billing information if said billing information was determined to be transmitted via printed transmission;
converting said billing information for electronic transmission if said billing information was determined to be transmitted via electronic transmission; and
generating an electronic billing statement from said converted billing information if said billing information was determined to be transmitted via electronic transmission.

Comesanas' invention relates to computer programs, specifically to computer software which directs the printing of customer invoices to include current billing information and transmittal charges for a pre-paid return envelope which the customer will receive with the invoice for use in return of the invoice payment and which also directs collation or assembly of the pre-paid return envelope, the invoice, and the shipping envelope in which the invoice and pre-paid return envelope will be sent to the customer.

As shown in Figures 1-2, Comesanas' invention provides an automated, computer-directed means by which banking institutions and credit card companies may attempt to expedite the return of invoice payments. At the same time Comesanas' invention provides a service for customers by providing the customer with a time saving pre-paid envelope for return of an invoice payment. In the preferred embodiment, after the computer software billing system is properly loaded into the computer memory and executed, the computer would access a database containing debtor account

information. Then after reviewing information presented for the first debtor account, the

computer would decide whether a payment was required for that debtor, and, if so,

generate an invoice for the first debtor account so that the creditor's address is in a

consolidated position on the invoice for use with a return envelope having a window and

so that the debtor's current address is also in a consolidated position on the invoice for

use with a shipping envelope having a window. The computer would then determine

from the information in the database whether or not the first debtor has signed an

agreement to pay transmittal charges associated with a return envelope. If the debtor

has signed such an agreement, the transmittal charges would be added to the invoice.

The computer would then direct a printer to print an invoice for the first debtor.

Comesanas teaches (column 3, lines 5-45) that:

> In a second embodiment of the present invention (not shown), it is contemplated
> for a creditor have the option to eliminate the step of printing a paper copy of the
> invoice when the invoice information is electronically transmitted to the debtor.
>
> Transmittal of the invoice to each debtor is contemplated in two ways. In
> today's business environment a shipping envelope is routinely required.
> However, in the future, it is contemplated for transmittal of invoices and invoice
> payments to be accomplished electronically and for the existence of transmittal
> charges for such electronic transmittal. The present invention can be used in an
> all-electronic business environment whereby, for the debtor's convenience in
> being allowed to make return payments electronically, the debtor signs a print
> written agreement that he authorizes being billed on his or her invoice for
> electronic transmittal charges that would otherwise be incurred by the creditor for
> such electronic return payment and for which the creditor would be unwilling to
> pay Should envelopes be required, the computer will determine whether an
> address is needed for either the shipping envelope or the pre-paid return
> envelope. If addresses are required, the computer will direct a printer to print the
> creditor's address on the pre-paid return envelope and the debtor's current

address on the shipping envelope. It is not critical to the present invention which envelope is printed first. The computer will then direct a postage metering device to print transmittal charges onto the shipping envelope and onto the return envelope as needed. Again, it is not critical to the present invention which envelope is printed first. The computer-aided billing system will then have the computer direct the collation or assembly of the pre-paid return envelope, the shipping envelope, and the invoice for transmittal to the customer. This process is repeated for each successive debtor in the database. As the operating speeds of printers and postage metering devices are variable, the order of the steps included herein may be varied to the extent necessary to maximize the efficiency of each printer and each postage metering device used by a creditor without departing from the fundamental intent of the present invention.

Claims 3 and 4 of Comesanas read as follows:

3.   A computer program comprising the steps of directing a computer to access a database containing debtor account information; directing said computer to read said debtor account information for each successive debtor in said database; compiling current billing information from said debtor account information for selected ones of said debtors from whom a payment is required so as to generate an invoice for each of said selected debtors; determining whether each of said selected debtors has signed an agreement to pay transmittal charges for return payment and if such an agreement was signed, directing said computer to compile said transmittal charges for said return payment into the ones of said invoices generated for each of said selected debtors who had signed such an agreement; determining whether each of said invoices is to be sent electronically or by mail, and if by mail directing a printer to print a paper copy of each of said invoices to be sent by mail: directing said printer to address a return envelope with the address of each of said selected debtors who has signed an agreement to pay transmittal charges for return payment, and further directing the collation of an invoices a shipping envelope, and a prepaid return envelope for each of said selected debtors who has signed an agreement to pay transmittal charges for return payment by mail so that said current billing information in said invoices can be transmitted to each of said selected debtors in said database from whom a payment is required.

4.   The computer program of claim 3 wherein said step of determining whether each of said selected debtors has signed an agreement to pay

transmittal charges for return payment comprises the step of determining whether said return payment is to be made electronically, and if so directing said computer to compile said transmittal charges for said electronic return payment into the ones of said invoices generated for each of said selected debtors who had signed such an agreement.

In the rejection of claim 18 under 35 U.S.C. § 103 (answer, pp. 3-5), the examiner implicitly ascertained that Comesanas, either expressly or inherently described, every limitation of claim 18 except for the steps of (1) converting the billing information for electronic transmission if the billing information was determined to be transmitted via electronic transmission; and (2) generating an electronic billing statement from the converted billing information if the billing information was determined to be transmitted via electronic transmission.

With regard to these differences, the examiner (answer, p. 5) took Official Notice that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer and then concluded that "it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission." Implicit in this rejection is the examiner's view that

the above noted modification of Comesanas would result in a method which

corresponds to the method recited in claim 18 in all respects.

The appellant does not dispute the obviousness of the above-noted modification

of Comesanas, however, the appellant does argue throughout both briefs that such a

modification of Comesanas would not result in a method which corresponds to the

method recited in claim 18 in all respects. Specifically, the appellant argues that

Comesanas does not teach or suggest "prescribing delivery preferences for said billing

information" and "associating said delivery preferences with said billing information to

determine if said billing information is to be transmitted via printed transmission or

electronic transmission." We do not agree.

In our view, the teachings of Comesanas, taken as a whole, instructs an artisan

that the debtor/customer chooses the delivery manner from the choices provided by the

biller. In this instance, Comesanas teaches that the biller provides three choices for

delivery of the invoice as follows: (1) by mail without a pre-paid envelope; (2) by mail

with a pre-paid envelope with the invoice reflecting the cost of the pre-paid envelope;

and (3) by electronic transmission with the invoice reflecting the transmittal charges of

the electronic transmission. Comesanas then teaches that the biller utilizes the

selected delivery choice for transmitting the invoice to the debtor/customer. As such,

Comesanas does teach and suggest "prescribing delivery preferences for said billing

information" and "associating said delivery preferences with said billing information to

determine if said billing information is to be transmitted via printed transmission or

electronic transmission."

For the reasons set forth above, the decision of the examiner to reject claim 18

under 35 U.S.C. § 103 is affirmed.

The decision of the examiner to reject claims 12, 14 to 17 and 19 to 36 under

35 U.S.C. § 103 is also affirmed since the appellant, as noted above, has grouped

claims 12 and 14 to 36 as standing and falling together and has not argued separately

the patentability of any particular claim apart from the others. See In re Young, 927

F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638,

642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv)).

<div align="center">CONCLUSION</div>

To summarize, the decision of the examiner to reject claims 12 and 14 to 36

under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal

may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHARLES E. FRANKFORT	)
Administrative Patent Judge	)
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	)
	)
	) BOARD OF PATENT
MICHAEL R. FLEMING	) APPEALS
Administrative Patent Judge	) AND
	) INTERFERENCES
	)
	)
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JEFFREY V. NASE	)
Administrative Patent Judge	)

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